REMARKS

Applicant respectfully requests reconsideration and allowance of the subject-application. Claims 1, 6, 8, 17, 21, 23, 25, 31, 37, and 39 are amended. New claims 40-42 are added. Claims 1-6, 8-25, 27-33, and 35-42 are pending in this application.

Claims 6, 8-12, 17-24, 33, and 35-36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,838,313 to Hou et al. (hereinafter "Hou") in view of U.S. Patent No. 6,081,829 to Sidana (hereinafter "Sidana"), U.S. Patent No. 5,923,848 to Goodhand et al. (hereinafter "Goodhand"), and U.S. Patent No. 5,526,407 to Russell et al. (hereinafter "Russell").

The subject application is a continued prosecution application (CPA) filed May 17, 2001. Pursuant to 35 U.S.C. §103(c), which was amended effective Nov. 29, 1999 (Public Law 106-113),

> Subject matter developed by another person, which qualifies as prior art only under one or more of sub-sections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Both the subject application and the Goodhand reference were owned by, or subject to an obligation of assignment to, the same person at the time the invention of the subject application was made. Given that the filing date of the subject application is after November 29, 1999, Applicant respectfully submits that the Goodhand patent is not a useable prior art reference under 35 U.S.C. §103(a) for the subject application.

35 U.S.C. § 103

Applicant respectfully submits that the rejected claims 1-6, 8-25, 27-33, and 35-39 are allowable over the cited references. Nonetheless, claims 1, 6, 8, 17, 21, 23, 25, 31, 37, and 39 are amended herein to further distinguish the claims over the cited references.

Claims 1-5, 13-16, 25, 27, 31-32, and 37-39 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,838,313 to Hou et al. (hereinafter "Hou") in view of U.S. Patent No. 6,081,829 to Sidana (hereinafter "Sidana"). Applicant respectfully submits that claims 1-5, 13-16, 25, 27, 31-32, and 37-39, as amended, are not obvious over Hou in view of Sidana.

Hou discloses a multimedia-based reporting system that allows drawing, text, and audio recording annotations to be added to the report (see, col. 2, lines 40-61, and col. 6, lines 52-66). The reporting system of Hou includes an annotation input interpreter that provides an interface between the user annotation input and three types of annotation handlers that can add annotations to a "canvas" of the report: a static annotation handler, a dynamic annotation handler, and an annotation on annotation handler (see, Fig. 9, and col. 6, lines 25-29).

Sidana is directed to general purpose web annotations without modifying the browser. In Sidana, a "redirector" is situated between a client browser and a server including a web document (see, Fig. 1). The redirector stores the user's annotations to the web document, so the next time the user's client browser requests the web document, the request is routed through the redirector which adds

the user's previous annotations to create an augmented web document that is displayed to the user. See, col. 4, lines 57-67, and col. 1, line 55 – col. 2, line 32.

With respect to amended **claim 1**, amended claim 1 includes:

> an annotation server, coupled to the client computer, to . . .
> > analyze electronic mail messages that are received not in reply to a previous electronic mail message that included annotation data, to locate data in the electronic mail messages,
> > generate new annotations that include the located data, and
> > add the new annotations to the annotation database.

In contrast, the manner in which annotations are created in Hou can be seen in Figure 9 of Hou. As illustrated in Fig. 9, user annotation input 36 is provided to an annotation input interpreter, which forwards the input to either static annotation handler 37, annotation on annotation handler 38, or dynamic annotation handler 39. These three handlers 37, 38, and 39 allow for the addition of different annotation inputs (e.g., drawings, text, or voice) to the report 32 (see also, col. 6, lines 26-37). After all annotations have been generated and added to report 32 by the interpreter 24 and handlers 37, 38, and 39, mail report handler can generate an e-mail message for delivery (see also, col. 6, lines 14-16, and col. 4, lines 25-31).

Thus, Hou discloses generating annotations and adding them to a report, and then generating an email message including the report. In amended claim 1, on the other hand, annotations are generated to include data that is included in electronic mail messages that are received not in reply to a previous electronic mail message that included annotation data. Amended claim 1 is thus distinguishable over Hou because Hou generates annotations to be added to a report and then includes the report in an email message, whereas in the system of

claim 1 the analyzed electronic mail messages include data that will become an annotation but that is not yet a generated annotation.

In the Supplemental Advisory Action mailed April 18, 2001, various portions of Hou were cited as disclosing "generation of an e-mail message containing annotation, where generated e-mail message is not in response to a sent message" (see, ¶ 3, p. 1). However, Applicant respectfully submits that, with regard to the analyzed electronic mail messages in amended claim 1, the annotation server generates annotations using data located in the analyzed electronic mail message rather than generating an electronic mail message including an annotation.

Hou also discloses an annotation on annotation handler that allows a user to select a desired segment of an annotation and make a new annotation which is a reply to this selected segment (see, col. 9, lines 14-24). However, this annotation on annotation handler allows a new annotation to be made that is a reply to a selected segment – nowhere does Hou disclose that this annotation on annotation handler can generate new annotations that include data located in electronic mail messages that are received not in reply to a previous electronic mail message that included annotation data as claimed in amended claim 1.

Applicant respectfully submits that Sidana is not cited as curing the above-referenced deficiencies of Hou, and furthermore that Sidana does not cure the above-referenced deficiencies of Hou. Thus, Applicant respectfully submits that claim 1 is allowable over Hou in view of Sidana for at least the reasons discussed above.

With respect to **claim 37**, Applicant respectfully submits that, analogous to the discussion above regarding claim 11, Hou and Sidana do not disclose or suggest locating data in a received electronic mail message and generating a new annotation from the data in the electronic mail message as claimed in claim 37. Thus, Applicant respectfully submits that claim 37 is allowable over the cited references for at least these reasons.

With respect to **claim 13**, claim 13 includes:

> generating an electronic mail message including . . .
> an installation option that identifies an installation program that can be used to install one or more modules allowing the content and corresponding media content to be rendered;

Claim 13 stands rejected under the combination of Hou and Sidana. However, the January 17 Office Action states that Hou and Sidana do not teach an installation option (see, ¶4, p. 6), which is included in claim 13. Russell is asserted in the January 17 Office Action as disclosing an installation option that identifies an installation program that can be used to install one or more modules allowing the content and corresponding media content to be rendered (see, ¶4, p. 6). Presumably, claim 13 was intended to be rejected under the combination of Hou, Sidana, Goodhand, and Russell. As discussed above, Applicant respectfully submits that the Goodhand patent is not a useable prior art reference under 35 U.S.C. §103(a) for the subject application.

However, for the sake of argument, Applicant respectfully submits that Russell does not disclose or suggest generating an electronic mail message including an installation option as claimed in claim 13.

In the Supplemental Advisory Action mailed April 18, 2001, Russell is cited as disclosing "an installation option that identifies an installation program" (see, ¶ 4, p. 1). The language referenced in Russell for this assertion is:

> The operating system sub-programs 171 consist of the Windows 3.1 operating system, the multimedia extensions which come as part of the retail package containing the operating system, and the device drivers selectively loaded when the PC is configured.

See, ¶ 4, p. 1. Applicant respectfully submits that this disclosure in Russell of configuring a PC does not disclose or suggest generating an electronic mail message including an installation option as claimed in claim 13. Russell does not include any discussion of an installation option that identifies an installation program used to install one or more modules allowing the content and corresponding media content to be rendered being included in an electronic mail message as claimed in claim 13. Although Hou does discuss an e-mail system and a mail report handler, Applicant respectfully submits that the mere existence of e-mail does not suggest including in an electronic mail message an installation option that identifies an installation program used to install one or more modules allowing the content of a new annotation included in the message as well as the corresponding media content to be rendered as claimed in claim 13.

Thus, Applicant respectfully submits that Russell does not cure the deficiencies of Hou, and that claim 13 is allowable over the cited references for at least the reasons discussed above.

With respect to new **claim 40**, new claim 40 depends from claim 13 and Applicant respectfully submits that new claim 40 is allowable over the cited references for at least the reasons discussed above with respect to claim 13. Furthermore, new claim 40 recites that the installation option comprises a user-

selectable link that identifies the installation program. Applicant respectfully submits that neither Russell nor any of the other cited references disclose or suggest that - the installation option that - identifies an installation program comprises a user-selectable link that identifies an installation program as claimed in new claim 40. Thus, for at least these reasons, Applicant respectfully submits that claim 40 is allowable over the cited references.

With respect to amended **claim 25**, in both the January 17 Office Action (see, ¶3, p. 2) and the Supplemental Advisory Action mailed April 18, 2001 (see, ¶ 4, p. 1), it was asserted that Hou teaches (at col 6/lines 61-66, col 7/lines 1-3, col 8/line 61-63, and col 9), an identifier of a temporal range of the media content that the new annotation content is associated with, which corresponds to a location of the media content that is after the beginning of the media content and at which rendering of the media content should begin in response to selection of the identifier of the media content in the electronic mail message (see, ¶3, p. 2).

Amended claim 25 includes:

> a module to generate an electronic mail message regarding the new annotation, the electronic mail message including . . .
>> a user-selectable link to the media content, wherein the link includes an identifier of the media content to which the new annotation corresponds, and an identifier of a temporal range of the media content that the new annotation content is associated with, wherein the temporal range corresponds to a location of the media content that is after the beginning of the media content and at which rendering of the media content should begin in response to selection of the link in the electronic mail message.

Applicant respectfully submits that Hou does not disclose or suggest an electronic mail message including a user-selectable link to media content, wherein the link includes an identifier of a temporal range that corresponds to a location of

the media content at which rendering of the media content should begin in response to selection of the link in the electronic mail message as claimed in amended claim 25.

In Hou, a dynamic annotation can be displayed along a time-line with some markers that divide the time-line into time intervals (see, col. 8, lines 43-45 and 64-65). Additionally, using the markers along the time line an individual can select a desired segment of an annotation and play back the annotation or make a new annotation (see, col. 9, lines 14-18). However, there is no discussion in Hou of a user-selectable link in an email message and in response to selection of the link beginning streaming of media content at a location corresponding to the temporal range as claimed in amended claim 25. Hou discloses that a report from a mailbox can be loaded from a message selected by the user from the mailbox (see, col. 4, lines 12-14). However, Applicant respectfully submits that the mere mention that the "report is loaded from the message" does not disclose or suggest including a user-selectable link to media content, wherein the link includes an identifier of a temporal range that corresponds to a location of the media content at which rendering of the media content should begin in response to selection of the link in the electronic mail message as claimed in amended claim 25.

Additionally, in the Supplemental Advisory Action mailed April 18, 2001 Russell is cited (see, ¶ 4, p. 2) as disclosing "comprising identifier's of temporal range of media content" as follows:

> App.exe ..create specialized windows, timers, and file management systems, ... the operation of App.exe is governed by the two timers, ..., and by user events generalized in FIG. 18 as keyboard events 193 and mouse events 195; (col 18/lines 26-56,

Figs, 6-18, rendering content and multimedia content, also comprising identifier's of temporal range of media content)

Russell discloses a Phrase ID data element consisting of the time and date of the beginning of a phrase, and a Phrase Attribute data element containing the duration of the phrase (see, col. 18, lines 5-8 and 53-56). Applicant respectfully submits that the data elements containing the time and duration of a phrase do not disclose or suggest an electronic mail message including a user-selectable link to media content, wherein the link includes an identifier of a temporal range that corresponds to a location of the media content at which rendering of the media content should begin in response to selection of the link in the electronic mail message as claimed in amended claim 25.

Applicant respectfully submits that Sidana is not cited as curing the above-referenced deficiencies of Hou, and furthermore that Sidana does not cure the above-referenced deficiencies of Hou. Thus, Applicant respectfully submits that amended claim 25 is allowable over the cited references for at least the reasons discussed above.

With respect to amended **claim 31**, amended claim 31 includes:

> including, in the reply, an identifier of one or more annotation sets of a plurality of annotation sets that the new annotation is associated with, wherein the annotation sets correspond to categories for annotations; and
> displaying a default recipient, corresponding to the identified one or more annotation sets, that is to receive an electronic mail notification of the new annotation.

Claim 31 stands rejected under the combination of Hou and Sidana. However, the January 17 Office Action does not identify any portion of either Hou or Sidana that discloses a default recipient, corresponding to the identified one or more annotation sets, that is to receive an electronic mail notification of the new

annotation, as claimed in claim 31. On the other hand, the January 17 Office Action does state (see, ¶3, p. 4) that Goodhand discloses displaying a default, corresponding to the identified one or more annotation sets, that is to receive an electronic mail notification of the new annotation. Presumably, claim 13 was intended to be rejected under the combination of Hou, Sidana, and Goodhand. As discussed above, however, Applicant respectfully submits that the Goodhand patent is not a useable prior art reference under 35 U.S.C. §103(a) for the subject application.

Thus, Applicant respectfully submits that Hou and Sidana do not disclose or suggest the method of amended claim 31, and that amended claim 31 is allowable over the cited references for at least the reasons discussed above.

With respect to **claims 2-5, 14-16, 27-30, 32, and 38-39**, given that claims 2-5 depend from amended claim 1, claims 14-16 depend from claim 13, claims 27-30 depend from amended claim 25, claim 32 depends from amended claim 31, and claims 38-39 depend from amended claim 37, Applicant respectfully submits that claims 2-5, 14-16, 27-30, 32, and 38-39 are likewise allowable over the cited references for at least the reasons discussed above with respect to their corresponding independent claims.

Claims 6, 8-12, 17-24, 33, and 35-36 stand rejected under 35 U.S.C. §103 as being unpatentable over Hou in view of Sidana, Goodhand, and Russell. As discussed above, however, Applicant respectfully submits that the Goodhand patent is not a useable prior art reference under 35 U.S.C. §103(a) for the subject application. Applicant respectfully submits that the combination of Hou, Sidana, and Russell, without Goodhand, is not cited as disclosing the subject matter in

claims 6, 8-12, 17-24, 33, and 35-36, and Applicant respectfully submits that Hou, Sidana, and Russell do not disclose or suggest the subject matter in claims 6, 8-12, 17-24, 33, and 35-36. Thus, Applicant respectfully submits that claims 6, 8-12, 17-24, 33, and 35-36 are allowable over the cited references for at least the reasons discussed above.

Applicant respectfully requests that the §103 rejections be withdrawn.

<u>Version of Claims with Markings to Show Changes Made</u>

1.   (Twice Amended) A system comprising:

a client computer to playback multimedia content and annotations corresponding to different temporal portions of the multimedia content; and

an annotation server, coupled to the client computer, to,

<u>maintain an annotation database having a plurality of annotations corresponding to the multimedia content,</u>

provide the plurality of annotations to the client computer for playback,

send electronic mail messages including annotations to recipients identified by the client computer,

[generate new annotations based on electronic mail messages received both in response to the sent electronic mail messages and not in response to the sent electronic mail messages; and]

<u>analyze electronic mail messages that are received not in reply to a previous electronic mail message, that included annotation data, to locate data in the electronic mail messages,</u>

<u>generate new annotations that include the located data, and</u>

add the new annotations to the annotation database.

6.   (Twice Amended) A method comprising:

presenting, to a user, a user interface allowing the user to create a new annotation corresponding to media content;

including, as part of the user interface, a field via which the user can identify a recipient that is to receive an electronic mail notification of the new annotation; and

communicating, as an electronic mail message that is not in reply to another electronic mail message, the new annotation to an annotation server, wherein the electronic mail message includes the new annotation and an identifier of the media content but does not include the media content.

8.   (Twice Amended)   A method as recited in claim 6, further comprising including, in the electronic mail message, an indication of <u>one of a plurality of annotation sets, the one</u> [an] annotation set corresponding to the media content and to the new annotation.

17.   (Twice Amended) A method comprising:

receiving an electronic mail notification of a new annotation corresponding to media content, the new annotation corresponding to one of a plurality of temporal segments after the beginning of the media content;

presenting the electronic mail notification to a user;

receiving a user <u>selection of an identifier, within the electronic mail notification, of</u> [input to access] the media content; and

accessing, [upon receiving] <u>in response to</u> the user <u>selection</u> [input], a media server to stream, for rendering to the user, the media content beginning with the one of the plurality of segments that corresponds to the new annotation.

21. (Amended) A method as recited in claim 17, wherein the receiving a user [input] <u>selection</u> comprises receiving a user selection of a uniform resource locator (URL) of the media content.

23. (Twice Amended) One or more computer-readable media having stored thereon a computer program that, when executed by one or more processors, causes the one or more processors to perform functions including:

receiving an electronic mail notification of a new annotation corresponding to media content, wherein the electronic mail notification includes a user-selectable identifier of the media content;

displaying the electronic mail notification;

receiving a user selection of the identifier; and

<u>automatically</u> accessing, [upon receiving] <u>in response to</u> the user selection <u>of the identifier of the media content</u>, a media server indicated by the identifier to begin, at a point in the media content after the beginning of the media content and corresponding to the new annotation, streaming the media content for presentation to the user.

25. (Twice Amended) A system comprising:

an interface module to receive data regarding a new annotation corresponding to media content;

a module to generate an electronic mail message regarding the new annotation, the electronic mail message including,

the new annotation content,

a user-selectable link to the media content, wherein the link includes

an identifier of the media content to which the new annotation corresponds,

and an identifier of a temporal range of the media content that the new

annotation content is associated with, [which] wherein the temporal range

corresponds to a location of the media content that is after the beginning of

the media content and at which rendering of the media content should begin

in response to selection of the [identifier of the media content] link in the

electronic mail message.

31.   (Twice Amended) A method comprising:

receiving an electronic mail notification of an annotation corresponding to

media content;

replying to the electronic mail notification to generate a new annotation

corresponding to the media content;

including, in the reply, an identifier of one or more annotation sets of a

plurality of annotation sets that the new annotation is associated with, wherein the

annotation sets correspond to categories for annotations; and

displaying a default recipient, corresponding to the identified one or more

annotation sets, that is to receive an electronic mail notification of the new

annotation.

37.   (Twice Amended) One or more computer-readable media having

stored thereon a computer program that, when executed by one or more

processors, causes the one or more processors to perform functions including:

receiving an electronic mail message that is not in reply to a previous electronic mail message; [and]

locating data in the received electronic mail message;

generating a new annotation from the located data in the electronic mail message; and

adding the new annotation to an annotation store.

[extracting both annotation content and annotation identification information from the electronic mail message.]

39.   (Twice Amended) One of more computer-readable media as recited in claim 37, wherein the extracting annotation identification information comprises extracting from the email message:

an identifier of media content to which the annotation content corresponds and of a temporal segment, corresponding to the annotation content, of the media content; and

an identifier of an annotation set that a new annotation including the extracted annotation content is to be part of, wherein the annotation set is one of a plurality of [one or more] annotation sets corresponding to categories for annotations.

Conclusion

Claims 1-6, 8-25, 27-33, and 35-42 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

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